

In re Reissue Patent Application
for Patent No. 5,711,100
WILLIAM A. ELMER
Serial No. 10/098,648

REMARKS

Claims 1-25 remain in the case. New Claim 26 was added with the amendment filed in response to the Office Action of October 29, 2003. Claims 1-25 were rejected in the Office Action under 35 U.S.C. §251 with respect to the reissue declaration. Claims 4-6, 10, 11 and 13-17 were rejected under 35 U.S.C. §112. Claims 2, 3 and 13-17 were rejected under 35 U.S.C. §103. Additionally, the specification was objected to with regard to Claims 4-6, 10, 11 and 13-17. Applicant respectfully requests reconsideration of these grounds of rejection and objection in view of the amendments set out above, the following remarks and the accompanying Attachments A-C. For the convenience of the Examiner, the following arguments including arguments represented from the earlier filed amendment of January 26, 2004 are herein presented as guided by the above referenced Office Communication with reference made to the Office Action of October 24, 2003, Paper No. 14.

1. Rejection on Basis of Reissue Declaration

At page 2 of the Office Action, Claims 1-25 were rejected under 35 U.S.C. §251 on the basis of an alleged defective reissue declaration. Applicant respectfully requests reconsideration of this ground of rejection and asks that the attached reissue declaration be entered.

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The "Basis for Reissue" attached to the earlier-filed reissue declaration identifies six grounds for reissue, including at No. 6 "To add additional dependent claims because the original patent claims less than Applicant had a right to claim." In addition, the Examiner's being asked to consider the allegations that the "Autoangle sign" is prior art. Applicant respectfully submits that this ground alone, when taken together with the new dependent claims that have been added, clearly establishes a basis for reissue.

2. Submission of the Original Patent

At the bottom of page 2 of the Office Action, it is noted that the original patent must be submitted before the application can be allowed. Upon receipt of a Notice of Allowance, Applicant's undersigned counsel will promptly surrender the original patent grant to the PTO.

3. Failure to Underline Claims 7-18

At the bottom of page 2 bridging page 3 of the Office Action, it is correctly noted that Applicant failed to underline the subject matter of added Claims 7-18. This observation is well taken; the above restatement of Claims 7-18 includes complete underscores, and further includes any previous or current amendments.

4. The Drawing

A. Figure 1A

Consistent with the Examiner's comments regarding Figure 1A, Applicant has in the above amendment withdrawn the proposed correction to Figure 1A made in the July 14, 2003 amendment. That there is space between the assembly **126** and the sidewall of receptacle **112** is evident to one skilled in art from the specification.

B. Numeral **114**

The Examiner correctly notes that numeral **114** referenced at column 2, line 60 and 61 has been omitted in the drawing. Subject to the approval of the Examiner, there has been submitted a proposed amendment as Attachment B to Figure 1A in red ink.

C. New Formal Drawings

Following approval by the Examiner of the proposed change to Figure 1A, Applicant will submit new formal drawings. It is requested that this requirement be held in abeyance until receipt of a Notice of Allowance.

5. Objections to the Specification

Objections to the specification are set out at the bottom of page 3 bridging page 4 of the Office Action. Each of those objections are addressed next.

A. Claims 1, 4, 7-11 and 13-16: "Recess and Receptacle" Language

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The Examiner's comments with respect to the alternative language "recess" and "receptacle" are well taken. Appropriate amendment has been made in the specification relative to the paragraph at column 2, line 57-column 3, line 9 in order to refer to element 112 as an "indented recess or receptacle 112". The word "receptacle" having appeared in an original claim and clearly being an alternative term for the word "recess," no new matter is inserted with this amendment.

B. Claim 2: "Formed together" Language

Applicant respectfully submits that the phrase "formed together" is simply a modifier to the language "a completely enclosed hollow body"; that is, the word "together" does not mean that each side and end is attached to all of the other sides and ends (obviously, the two ends are not attached to each other, nor are the opposing sides). However, if the Examiner persists in this objection, Applicant submits that an appropriate resolution of the problem would simply be to remove the word "together" from the claim. Clearly, the specification supports the language "an advertising member having a base, ends and sides formed into a completely enclosed hollow body...".

C. Claims 7, 13 and 16: "Surround," "Surrounding" and "Surrounds" Language

Claims 7, 13 and 16 all clearly describe that which is shown in the drawing at Figures 1-3, that each recess or receptacle 112 is formed by the extension of the adjacent side 106 and the adjacent end 108 below the remainder of base 107 so as

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to surround the corresponding magnet assembly 126. Of course, it will also be appreciated that all of the recesses or receptacles 112 collectively surround all of the magnet assemblies 126. In order to allay the Examiner's concerns with respect to the "surround," "surrounds" and "surrounding" language, appropriate amendment has been made in the specification of the '100 patent in the paragraph at column 3, lines 33-45. Clearly, all of those features are shown in the drawing and would be appreciated by one skilled in the art as contributing to wind resistance. It is of course settled law that the original drawings alone provide a "written description" of the invention as required by 35 U.S.C. §112. Vas-Cath, Inc. v. Mahurkar, 19 U.S.P.Q. 2d 1111 (Fed. Cir. 1991) (holding that the drawings in a parent design application provided a sufficient written description under 35 U.S.C. §112 to support later claims in a continuation-in-part utility application); and Cooper Cameron Corp. v. Kvaerner Oilfield Products, Inc., 62 U.S.P.Q. 2d 1846 (Fed. Cir. 2002) (confirming the holding in Vas-Cath that drawings alone may meet the written description requirement).

D. Claim 9: "Base recessed relative to each magnet receptacle" Language

The Examiner's concerns regarding the language of Claim 9 are well taken, and is believed to be met by the amendment to Claim 9, the discussion in section C immediately above and the amendments at column 3, lines 33-45.

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E. Claims 10 and 11

Applicant submits that the above amendments and the remarks in sections C and D above meets the Examiner's concerns with respect to Claims 10 and 11.

F. Claim 12: "Edge" Language

The extension of the plastic coating over the edge of the magnet assembly 126 is clearly shown in the cross section of Figure 1A, which supports the amendment in this regard in the paragraph at column 2, line 57 bridging column 3, line 9 as set out above to add the language which reads "plastic material which extends over the edge of the assembly...".

G. Claim 14: "Receptacles extending below the base" Language

Applicant submits that the discussion in sections C and D above meets the issue raised in the Office Action with respect to Claim 14.

H. Claim 15: "Receptacle extends along...end" Language

Applicant submits that the concerns expressed in the Office Action regarding Claim 15 are met in the discussions in sections C and D above.

I. Claim 16: "Surrounds" Language

Applicant submits that the concerns regarding Claim 16 expressed in the Office Action are met in the discussion set out in section C above.

J. Claim 17: "Coating extending across a bottom surface" Language

Applicant submits that the concerns expressed in the Office Action regarding Claim 17 are met in the discussion regarding Claim 12 at section F above.

K. Claims 19 and 24: "Base comprises a unitary and rectangular sheet" Language

Figure 2 clearly illustrates that the base 107 is formed from a unitary and generally rectangular sheet of material, the entire sign being described as fabricated of "plastic" (column 2, line 43). An appropriate amendment has been made to the paragraph at column 2, lines 41-56 of the specification to incorporate the "unitary and rectangular sheet of plastic material" language appearing in Claims 19 and 24.

L. Claim 25: "adjacent side-adjacent end" Language

Applicant submits that the concerns expressed in the Office Action regarding the specification support for Claim 25 is met in the discussion set out in section C above.

6. Rejections Under 35 U.S.C. §112

At page 4 of the Office Action, Claims 4-6 were rejected under 35 U.S.C. §112, first paragraph. Additionally, Claims 4-6, 10-11 and 13-17 were rejected under 35 U.S.C. §112, second paragraph. These rejections are met in the following discussions.

A. Claims 4-6 (first paragraph)

The rejection of Claims 4-6 under the first paragraph of §112 is based upon the use of the term "non-magnetic." The Examiner correctly notes that the word

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"metallic" does not necessarily mean that the metal is "non-magnetic". However, for the metal housing 134 to be magnetic would be completely antithetical to Applicant's invention, since a magnetic housing 134 would repel the magnet 138. Therefore, one of ordinary skill in the art would easily recognize that the housing 134 must be fabricated from a non-magnetic metal (such as from any unmagnetized steel or from aluminum) or from a non-metallic material (such as plastic). In order to meet the Examiner's concerns in this regard, the paragraph at column 3, lines 10-18 of the specification has been amended to reference the metal housing 134 as "non-magnetic".

B. Claims 4-6 (second paragraph)

The concerns expressed in the Office Action regarding Claim 4, line 12 (the "non-magnetic" language is met in the discussion in section A above.

With respect to the concerns regarding the language at Claim 4, lines 15-19 and Claim 5, lines 2-5 regarding the elements which make up the fastening means, the Examiner correctly notes that the screw 128 is part of the fastening means and also part of the pivotal means. Applicant is not aware of any legal authority which precludes one element from performing part of one function and part of another function. Therefore, it is respectfully submitted that the language as it currently reads is not indefinite.

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C. Claim 10 (second paragraph)

The Office Action relative to Claim 10 expresses concern as to how the receptacle can extend below the base, since Claim 1 refers to the receptacle as being part of the base. But the two are not inconsistent; the recesses or receptacles 112 can be formed with and be part of the base 107, but still extend below the level of the remainder of the base. To emphasize this point, Claim 10 has been amended to describe the receptacle also extending below "the remaining portion of the base...".

D. Claim 13 (second paragraph)

The remarks above with respect to Claim 10 apply equally to Claim 13, for which an appropriate amendment has been made.

E. Claim 16 (second paragraph)

The Examiner's concerns regarding Claim 16 are well taken; appropriate amendment has been made to Claim 13 to remain the language "and surrounding one of the magnets", so that this limitation can now properly appear in Claim 16.

7. Claims 1-25 Are Not Obvious

The rejection of Claims 2, 3 and 13-17 under 35 U.S.C. §103 is continued in the Office Action, based upon the combination of the EP '194 (i.e., Canadian '396), George and Podoloff references. This rejection is continued in the face of the

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substantial affidavit evidence submitted by Applicant with the previous Office Action, those affidavits being dismissed as having no evidentiary effect. Respectfully, however, the collective affidavits provide forceful evidence that the subject matter of Claims 2, 3 and 13-17 would not be obvious in view of the applied combination of references.

A. Substantial Commercial Success Has Been Demonstrated

In her first affidavit at Exhibit 5 of the earlier Office Action, Mrs. Elmer stated under oath that (a) the commercial signs made according to the design described in the claims of this application enjoyed a substantial increase of sales in each year from 1994-2002 relative to sales in 1993, and which increase was several orders of magnitude in each year (§4), (b) that these substantial increases in sales were realized without a significant increase in advertising expenses during that time (§6), (c) commercial success was realized in spite of the fact that the signs made according to the design of the claims in this application was on the order of twenty percent more expensive than other signs which sold well prior to 1993 (§6), and (d) customers for these signs rely upon the specific features described in the claims (§§7 and 8).

At page 6 of the Office Action, Mrs. Elmer's declaration is dismissed as having no evidentiary value because it does not define the elements of Claims 2 and 3 and because the sales could have been due to "increases in advertising, reducing the sales price of the product, etc." While Applicant respectfully submits that Mrs.

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Elmer's earlier affidavit met any concerns regarding increases in advertising expenses and reduction in sales price, a supplemental affidavit of Mrs. Elmer is appended as Attachment C. In this supplemental affidavit, Mrs. Elmer makes it quite clear at ¶¶4-8 that the commercial success enjoyed from the sign made according to the claims of this application was not as a result of an increase in advertising expenditures or a reduction in the sales price.

Further, Mrs. Elmer's supplemental affidavit at Attachment C also makes it clear that the sign design which has enjoyed commercial success employs the construction features of Claims 2, 3 and 13-17 (Supplemental Affidavit, ¶¶2 and 3).

Accordingly, Applicant respectfully submits that Mrs. Elmer's original and supplemental affidavits clearly demonstrate commercial success of the sign design made according to Claims 2, 3 and 13-17 and refute as a matter of law the suggestion of obviousness in view of the combination of applied references.

B. The Renfro Affidavit and the Definition of "Sleeve"

In his affidavit at Exhibit 9 of the earlier amendment, patent attorney Julian C. Renfro noted at ¶¶7 and 8 the definition of "sleeve" (appended to his affidavit as Attachment B), and pointed out that there was no corresponding "sleeve" in the EP '194 reference. The Office Action at page 9 contains a response which defines a "sleeve" as an "encasement into which an object fits." However, no reference is given to where that definition is found; certainly that language is not contained in the definition set out in Webster's Third New International Dictionary at Attachment

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B to Mr. Renfro's affidavit. Thus, Applicant respectfully traverses the reliance on this definition in the Office Action. Clearly, the resilient member is not a "sleeve" through which anything extends. In fact, this member 115 has a hollow core and is glued or otherwise attached to the magnet 112, a form of construction that is remarkably different than Applicant's.

C. Renfro Affidavit and Lack of "Pivotal" Disclosure

In his affidavit, Mr. Renfro also pointed out that the EP '194 reference only discloses that the magnets "are spatially movable at least in a restricted manner...". Mr. Renfro then further positively asserted that this language does not teach one of ordinary skill in the art that the magnets are pivotal so as to conform to the shape of the roof of the vehicle.

In reply, the Office Action states that "making the sleeve (115) out of a resilient rubber... would inherently allow the magnet to pivot." Applicant respectfully traverses this "inherency" argument, because the reference clearly does not teach that the magnets are intended to pivot in order to conform to the shape of the roof.

D. Renfro Affidavit and Independent Claim 3

At ¶9 of his affidavit, Mr. Renfro carefully notes that dependent Claim 3 "specifically recites that the fastener extends through the magnet, its flexible sleeve and into the base," pointing out that no such arrangement is disclosed in the EP '194 reference, since the head of the bolt 117 rests directly against the unnumbered

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washer which abuts the rail 114 (Figure 6 in EP '194). Clearly, the EP '194 reference does not disclose a fastener which extends through the magnet, through the flexible sleeve and into the base as recited in Claim 3.

E. Halyard Affidavit and "Sleeve" versus "Resilient Member"

In his affidavit, professional engineer Paul J. Halyard pointed out in ¶¶5-9 the significant differences between the flexible sleeve arrangement recited in Claim 2 and the resilient member construction in the EP '194 reference. The "real world" engineering considerations specifically enumerated by Mr. Halyard substantially highlight the significant differences between the specific limitations of Claims 2 and 3 and the applied references.

In response to Mr. Halyard's engineering analysis, the Office Action suggests that these are mere arguments for which there is insufficient proof. Respectfully, Mr. Halyard's opinion is evidence which is to be given considerable weight, just as the testimony of any expert witness is to be given weight in any evidentiary proceeding.

F. Claims 13-17 Define Features Not Found in the Combination of Applied References

At the bottom of page 5 bridging page 6 of the Office Action, Claims 13-17 are rejected under 35 U.S.C. §103 on the combination of the EP '194, George and Podoloff references. However, a careful analysis of the limitations of Claims 13-17

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demonstrates that these claims contain limitations not found in the combination suggested in the Office Action.

Claim 13 depends upon and further limits Claim 2 and recites plural magnet receptacles, each of which extends below a remaining portion of the base around each receptacle. Respectfully, there is no element in any of the applied references that corresponds to the "receptacles" disclosed in Applicant's specification and shown in the drawings as element 112. In the Office Action, it is suggested that element 14 of Podoloff constitutes a "housing" which extends below the magnetic member 12. However, element 14 is not a housing, but instead is simply "a resiliently deformable sleeve of generally annular shape..." (Podoloff reference, column 2, lines 61-62).

Claim 14 depends upon Claim 13 and recites that each receptacle extends along a portion of an adjacent side of the advertising member. Clearly, no such construction is demonstrated in the combination of references, particularly not Podoloff. Likewise, Claim 15 depends upon Claim 14 and recites that each receptacle extends along a portion of an adjacent end; for the same reasons, the applied references do not show this construction feature.

Claim 16 depends upon Claim 15 and further recites that each magnet receptacle surrounds at least one of the magnets. Because of its dependency upon Claims 13, 14 and 15, Claim 16 clearly defines over the Podoloff reference.

Claim 17 depends upon Claim 2 and adds a further limitation to that claim. Since Claim 2 is patentably distinct over the combination of the EP '194 and George references, the addition of Podoloff to a rejection of Claim 17 does not add anything to the deficiencies of the two principal references.

8. Summary and Conclusion

Applicant respectfully submits that the failure in the Office Action to treat as competent the affidavit evidence is contrary to case authority. In Ex Parte Remark, 25 U.S.P.Q. 2d 1498 (Fed. Cir. 1990), the Federal Circuit held that a nexus of commercial success is established when the evidence clearly demonstrates that there was commercial success, and that the commercial success was due to the merits of the claimed invention. Unquestionably, in her first affidavit attached as Exhibit 5 to the earlier amendment, Mrs. Sharon Elmer, in addition to demonstrating commercial success, established a nexus between that commercial success and the specific features which are the subject of Claims 1-25. Particularly pertinent is Mrs. Elmer's testimony at ¶¶7 and 8, reproduced next:

7. Each of the signs sold by HTH referenced in the chart above contained all of the elements recited in the claims of the '100 patent and the new claims added in the reissue application. In discussions with customers who have purchased the signs made according to the '100 patent, I have learned that a number of the claimed features and the overall combination of features has

contributed significantly to the commercial success of the signs manufactured and sold by HTH in accordance with the '100 patent.

8. For example, I have learned that customers rely upon (a) the stability of the sign while attached to a vehicle in operation, achieved in part through the recessing of the unitary base within the sides of the completely enclosed sign; (b) the use of multiple spaced magnets each employing a dish-shaped non-magnetic housing around the magnet to facilitate the easy removal of the sign, despite the hold-down capabilities of the multiple magnets; and (c) the ability of the sign to conform to the shape of different vehicle roof tops through the facile use of the flexible sleeve-fastener combination with the magnets, which further facilitates the decoupling of the magnets when the sign is being removed.

Accordingly, it is respectfully submitted that commercial success has been clearly demonstrated, and any concerns expressed in the Office Action regarding Mrs. Elmer's first affidavit are met with the supplemental affidavit of Attachment C hereto.

The affidavit of patent attorney Julian C. Renfro, Esquire should also be given due consideration, since Mr. Renfro defines the word "sleeve" and specifically points out that there is nothing that meets this language in the description of the EP '194 Canadian counterpart.

Further, the affidavit of professional engineer Paul J. Halyard should also be given full consideration, since Mr. Halyard points out why the distinctive differences between Applicant's sleeve arrangement and the hollow core of the EP '194 reference differs in terms of how each will function in a failure mode. It is also

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submitted that Mr. Halyard's reliance upon the engineering study set out at Attachment B to Mr. Halyard's affidavit (Exhibit 10 to the earlier amendment) must be given due consideration, when taken together with Mr. Halyard's opinions regarding the effect of that engineering study. Indeed, Mr. Halyard's failure mode analysis clearly demonstrates an unexpected result which is achieved by Applicant's construction, and comports with the decision of *In re Soni*, 34 U.S.P.Q. 1684 (Fed. Cir. 1995).

Applicant respectfully submits that Claims 1-26 are in a condition for allowance in view of the amendments and remarks set out above. If the further prosecution of this application can be facilitated through a telephone interview between the Examiner and the undersigned, the Examiner is respectfully requested to telephone the undersigned at the Examiner's convenience.

Respectfully submitted,



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